

REMARKS/ARGUMENTS

Applicants acknowledge with appreciation the courtesy of an interview granted to Applicants representatives on May 07, 2008. Favorable reconsideration of this application in view of those discussions and the following remarks is respectfully requested.

The Outstanding Rejections

Claims 33-68 are currently active in this case. In the outstanding office action, the 37 CFR 1.131 declarations were deemed ineffective; claims 56-63 and 65 were rejected under 35 USC 103(a) as being unpatentable over U.S. patent No. 5,742,668 to Pepe et al. in view of U.S. patent No. 5,493,564 to Mullan; claims 33, 34, 40-47, 54, 55, and 64 were rejected under 35 USC 103(a) as being unpatentable over US patent No. 5,941,956 to Shirakihara et al. in view of US Patent No. 5,159,592 to Perkins; claims 35-38 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Dunn; claim 39 was rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Pepe; claims 48-53 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara further in view of Pepe; and claims 66-68 were rejected under 35 USC 103(a) as being unpatentable over Pepe in view of Dunn.

Pepe and Mullan

Pepe is directed to a system for allowing a user to send or receive messages from a plurality of locations including the user's PDA, home computer, and office PC. See Figure 19, column 3 lines 19-27, and column 22 lines 42-52 of Pepe. The official action acknowledges that "Pepe does not specifically teach configuring the received message" to appear to originate at the sender's email address associated with the host system. Applicants agree. However, the official action asserts that:

Mullan taught a forwarding component configures the received message, prior to forwarding to the message recipient, such that the received message appears to the message recipient as if the received message originated at the sender's

email address associated with the host system, thereby allowing messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system (col. 7, lines 34-37; column 8, lines 18-25).

Applicants respectfully traverse.

Mullan is directed to routing email messages using the x.400 addressing scheme.

Mullan purports to solve one addressing problem created by an administration management domain ("ADMD") situated in one country servicing a user residing in a different country.

See column 3 lines 23-35 of Mullan, which state:

A user in the United States sending a message to a user in Ireland would naturally expect to specify a country code for Ireland (e.g., "IR") in the recipient address. Current telecommunications technology, however, does not preclude a system administrator from configuring the system so that Ireland users are actually serviced by a message transfer agent that also services United States users. In the parlance of the CCITF's X.400 standards, the Ireland users and the United States users reside in the same administration management domain. In this case the proper country code for a deliverable message sent to the user in Ireland would designate the United States (e.g., "U.S."). The potential for confusion among system users is substantial.

Mullan proposes a scheme to address this problem. According to the scheme, an ADMD includes a message transfer agent ("MTA") which uses inbound (26) and outbound (27) address conversion tables. The outbound conversion table enables the MTA of the ADMD to convert an internal address specified as an originator address of a message being sent by a user to a corresponding external address which "identifies the originator according to how that user is known to the outside world, rather than how the user is internally identified by the electronic messaging system" (column 11 lines 9-13). In particular, column 10 lines 10-16 of Mullan disclose that:

The values in ... Table 2 correspond to an electronic messaging system wherein a single administration management domain, denoted "TM" and located in the United States (country code "USA"), services users in three different countries: "USA", "JAPAN" and "MEXICO".

The address conversion is described at column 10 line 48 to column 11 line 13.

Here, Mullan applies the address conversion method to "facilitate routing of a message sent

by a user of a first electronic messaging system to a user of another electronic messaging system" (column 10 lines 48-51). In this example, the ADMD "TM" is located in the USA, but there are users residing in the USA, Japan, and Mexico. Mullan discloses converting the "internal originator address...to an external address by replacing the country code" such that the external address "identifies the originator according to how that user is known to the outside world, rather than how the user is internally identified by the electronic messaging system" (column 11 lines 3-13).

Further, Mullan discloses that the "internal originator address will thus be converted to an external address by replacing the country code and ADMD code" (column 11 lines 3-5). Thus, if the originator is operating in a first email system (e.g., country code "USA" and ADMD code "TM"), Mullan contemplates replacing "TM" with something which "identifies the originator according to how that user is known to the outside world, rather than how the user is internally identified by the electronic messaging system" (column 11 lines 9-13).

That is, the purpose of Mullan's technique is allows messages received and viewed by a recipient to appear to originate at an email address which is not the sender's actual email address in order to avoid confusion when using the X.400 addressing scheme. As such, Mullan teaches away from the transparency feature of the present invention, which "allows messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system." Because Mullan teaches away from the transparency feature of the present invention, it clearly does not remedy the deficiency of Pepe acknowledged in the official action. Thus, Pepe is not believed to anticipate or render obvious the subject matter defined by claim 56 when considered alone or in combination with Mullan.

Claim 60 requires (1) that messages generated at either the mobile client or the host system appear to originate at the message sender's first address and (2) that messages

generated at the host system by the message sender use a first address. Thus, claim 60 also defines the transparency feature of the present invention. For the reasons provided above regarding claim 56, Pepe is not believed to anticipate or render obvious the subject matter defined by claim 60 when considered alone or in combination with Mullan.

Shirakihara

In paragraph 4 of the outstanding office action, it is asserted that “The evidence submitted [in the 37 CFR 1.131 declarations submitted with the previous amendment] is insufficient to establish applicant’s alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Shirakihara reference.” (Emphasis supplied.) It is presumed that “after” should be –before--.

In paragraph 5 of the outstanding office action, it is asserted that “the affidavit is silent as to whether Applicant is using conception or reduction to practice as a basis for the affidavit.” In response, it is respectfully pointed out that each of the declarations (two by the named inventors Eggleston and Hansen and one by the corroborating witness Krebs) assert that “we successfully performed the steps recited in the claims now pending in this application” and that “we verified the functionality of the computer system recited in those claims” and that ¶ (19) of Eggleston’s declaration states that “annotated screen shots...reflecting the claims had been rendered to practice are attached....” Thus, it is respectfully submitted that it is clear that applicants are using actual reduction to practice in this country as the basis of their declarations. Moreover, it is noted that the examiner acknowledged that point during the interview on May 07, 2008.

In paragraph 5 of the outstanding office action, it is also asserted that:

the evidence provided uses the screen shots from the interview on May 17, 2007 with the inventors and Applicant’s representatives were provided. However, these screenshot cannot be used to substantiate Applicant’s claim of possession of the inventive subject prior to the date of the Shirakihara

Application No. 09/095,325
Reply to Office Action of April 25, 2008

reference (e.g. June 7, 2007) unless the screenshots are “original exhibits”. The affidavits appear to lack information as to the origin of the screenshots.

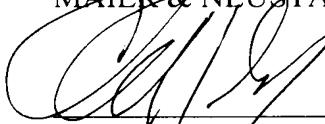
In response, it is respectfully submitted that the screen shots were made (just prior to the previous interview) from the programs generated and used successfully prior to the critical date of the Shirakihara reference. That is, they are the equivalent of recently made photographs of a device made and tested prior to the critical date of a reference. While applicants could, of course, submit copies of those programs, it is respectfully submitted that the screen shots illustrating the dates of those programs and how those programs work are far more revealing than the programs themselves. Again, the examiner acknowledged that point during the interview on May 07, 2008. However, the applicants stand ready to submit copies of the programs themselves if the examiner requires them.

Consequently, it is respectfully submitted that the Shirakihara patent is not available as 35 USC 102(e) art against applicants’ claims.

In view of the foregoing remarks and the attached declarations, no further issues are believed to be remaining. Applicants respectfully request that an interference be declared consistent with applicants’ suggestion of an interference.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Charles L. Gholz
Attorney of Record
Registration No. 26,395

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

W. Todd Baker
Registration No. 45,265